Essentially, the Examiner has repeated her previous position with regard to *Fowler et al.* but recognizes that *Fowler et al.* does not disclose (1) using a removed blank as the blank which is scanned for referencing the image printed on the blank or (2) inputting the difference between the actual spacing and the preset spacing as a corrective value manually. The Examiner has taken the position, however, that *Fowler et al.* discloses the blank being scanned while still attached to the continuous web in the machine and that *Stitcher* teaches use of a sensor means to determine proper placement of a printed image on the envelope as the envelope is being removed from the machine. Therefore, in the Examiner's view, it would have been obvious to one of ordinary skill in the art to place a sensor means for determining the reference edge of the printed image on the envelope at various locations in or outside the machine as taught by Stitcher and Fowler et al. who disclose sensor means in various locations.

With respect to claim 2, the Examiner has cited *Ruthenberg et al.* as support for her prior contention that it would have been obvious to *Fowler et al.* at the time the invention was made to modify the automatic inputting of the difference of the actual spacing and the preset spacing value into an electronic control of the machine by manually inputting the value difference because

a corrective value can be manually input into the control system of *Ruthenberg et al.*

This rejection is respectfully traversed.

As set forth in the claims, Applicant's invention provides a method for producing envelopes from a moving web of material in an envelope-producing machine that is usable with the in-line method of producing envelopes in which printing, scoring, cutting and folding takes place in one and the same machine. In accordance with the method recited in claims 1 and 2, a single blank, i.e. a finished envelope with printed images downstream of the printing station, is removed from the machine and used to determine the actual spacing of the printed image from a reference edge of the blank. The difference between the determined actual spacing of the printed image from the reference edge and a preset nominal spacing is computed, and this difference is input as a corrective value. In this way, a method for producing envelopes is provided which corrects the position of the printed image within the blank in a simple process behind the processing unit or at the outlet of the machine without requiring continuous upstream monitoring at the processing unit as is necessary with off-line web machines.

None of the cited references disclose a method by which correction is accomplished by removing a single blank for measuring purposes downstream of the processing unit and without the need for continual monitoring or teaches a system which determines the actual spacing of the printed image from the reference edge of a blank, computes the difference between the determined actual spacing and a preset spacing and inputs that difference as a correction value in a controller. In fact, all of the citations belong to the world of the so-called off-line web machines and are much too complicated for Applicant's purposes.

The primary reference to *Fowler et al.* does not detect the position of his markers within the finished envelope, but rather performs detection before cutting takes place. As discussed at Column 3, lines 10-25 of *Fowler et al.*, one sensor detects the marker, and a second one detects the position of the rotating knife cylinder further downstream. Comparing these signals, the controller "knows" if the cutting will take place in proper register or not. If not, the controller increases or decreases the speed of some feed rollers, until the knife will be in register with the marker. *Fowler et al.* does not determine the distance between marker and edge numeral, as recited in Applicant's claims. For him it is enough to know in what

direction he has to correct the speed of the feed rollers. That means, that *Fowler et al.* must continuously detect and correct the position of markers and knife in his system. See Column 8, lines 16-44. For example, as recited at Column 8, lines 21-23, *Fowler et al.* recites that "programmable controller 110 will continuously receive the output signals from scanner 90 and shaft encoder 100, and perform continuous comparison of the two outputs." (Emphasis added).

The defects and deficiencies of the primary reference to *Fowler et al.* are not remedied by any of the secondary references to *Stitcher* and *Ruthenberg et al.* Like *Fowler et al.*, *Stitcher* determines proper placement of an image on an web and not on a finished envelope after it has been removed from the machine. *Stitcher* teaches two different ways to determine proper placement. The first is by means of a strobe light (Column 4, line 58). This, of course, cannot be done on an envelope which has been removed from the machine. The second is by means of an electric eye. (See Column 5, lines 20-30). This electric eye continuously "reads" the markers as in *Fowler et al.* and sends signals to a pair of variable speed pull wheels located further downstream, which continuously corrects the speed of the web.

Ruthenberg et al. prints and cuts in line, but instead of working on a web, his machine works on blanks. Therefore, his problems are similar to the problems of off-line web machines. As in *Fowler et al.*, *Ruthenberg et al.* senses the position of the marker and the angular position of a processing head (Column 7, lines 18-45). The controller determines whether or not the processing head will be in registration with the marker. If not, it will accelerate or decelerate the speed of the processing head. *Ruthenberg et al.* uses two sensors (48 and 50) to detect the position of the blank itself and the position of the marker. This might cause the impression that he measures the distance, e.g. between the leading edge of the blank and the position of the marker. However, *Ruthenberg et al.* determines only whether or not the markers are within a so-called correction window (Column 2, lines 49-67). Therefore, here again, continuous monitoring and correction takes place.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or motivation supporting the desirability of making the specific combination that was made by the Applicant. In re Kotzab, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). Here, there is none. Nowhere does *Stitcher*, *Fowler et al.* or *Ruthenberg et al.* suggest Applicant's computation of the difference between a

preset spacing value and the determined actual spacing of the printed image from a reference edge within an imprinted blank removed from the machine downstream from the printing operation, or inputting that difference as a corrective value into control electronics of the machine. Although the Examiner states that *Stitcher* uses a sensor means to determine proper placement of a printing image on the envelope as the envelope is being removed from the machine, the solution *Stitcher* suggests is not Applicant's solution as *Stitcher's* strobe light cannot be used on an envelope removed from the machine and *Stitcher's* electric eye continuously "reads" the markers as in *Fowler et al.* Thus, it is respectfully submitted that the Examiner has failed to establish a prima facie case of obviousness based on any of these references.

Even if the references were combined in the manner suggested by the Examiner, one would still not achieve Applicant's method which requires no continuous monitoring and simply removes a single blank for measuring purposes behind the processing unit or at the outlet of the machine. In all of these references, continuous monitoring takes place upstream of the processing unit to make the necessary correction before the workpiece arrives at the processing unit. Whereas in Applicant's method, the results

are checked downstream of the processing unit without the need to monitor each and every workpiece as taught by these references.

In view of the foregoing, it is respectfully requested that the claims be allowed and that the application be passed to issue.

Respectfully submitted,
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I hereby certify that this correspondence is being sent by facsimile-transmission to the Assistant Commissioner for Patents, Washington, D.C. 20231, on March 10, 2003.

Frederick J. Dorchak